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Docket No.
121027-053

In Re Application Of: **Hideyuki ISHIKAWA**

Application No.	Filing Date	Examiner	Customer No.	Group Art Unit	Confirmation No.
09/864,836	May 24, 2001	Karin Riechle	35684	3761	4999

Title: **DISPOSABLE DIAPER AND PROCESS FOR MAKING THE SAME**

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Appl. No. 09/864,836



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Group
Art Unit: 3761

Attorney
Docket No.: 121027-053

Applicant: Hideyuki ISHIKAWA

Invention: DISPOSABLE DIAPER AND PROCESS
FOR MAKING THE SAME

Serial No.: 09/864,836

Filed: May 24, 2001

Examiner: Karin Reichle

Certificate Under 37 CFR 1.8(a)

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on January 26, 2007


Michael S. Gzybowski

CORRECTED BRIEF ON APPEAL

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Further to Appellant's Notice of Appeal filed April 24, 2006 in connection with the above-identified application, and the Notification of Non-Compliant Appeal Brief mailed December 26, 2006, appellant submits the present Corrected Brief on Appeal.

REAL PARTY IN INTEREST

Appellant has assigned this application to Uni-Charm Corporation in an assignment which

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was executed by the inventor on September 25, 2001, and filed in the United States Patent and Trademark Office on October 24, 2001 and recorded on January 2, 2002 at Reel No. 012417 and Frame No. 0823.

RELATED APPEALS AND INTERFERENCES

There are no related applications that are on appeal or involved in any interference.

STATUS OF CLAIMS

Claims 1-9 are pending in this application. Claims 1-6, 8 and 9 stand under final rejection, from which final rejection of claims 1 and 3 this appeal is taken. Claim 7 was withdrawn from the prosecution. No other claims are pending.

STATUS OF AMENDMENTS

A Supplemental Amendment after Final Rejection was filed in this application on June 7, 2006. As of the date of this corrected Brief on Appeal, the Examiner has acted on and denied entry of the Supplemental Amendment after Final Rejection.

SUMMARY OF CLAIMED SUBJECT MATTER

The present invention as set forth in the appended claims is directed to a disposable diaper that includes an elastically stretchable covering member 3 (shown in Fig. 1), 40 (shown in Fig. 6 and discussed in detail in the paragraph bridging pages 14 and 15 of appellant's original specification) for covering a diaper wearer's crotch region 8 (Fig. 1), 48 (Fig. 6) and front and rear waist regions, 46, 17 (Fig. 6), 6, 7 (Fig. 1).

The disposable diaper further includes a liquid-pervious sheet 2 (Fig. 1), 42 (shown in Fig. 6 and discussed in detail in the paragraph bridging pages 14 and 15 of appellant's original specification), the liquid-pervious sheet 42 having a skin contactable surface for contacting with skin of the diaper wearer.

The disposable diaper further includes a liquid-absorbent core member 4 (Fig. 1) 44 sandwiched between the liquid-pervious sheet 42 and the covering member 40 as shown in Fig. 7 and discussed in the paragraph bridging pages 14 and 15 of appellant's original specification).

Discrete elastic members 17 (Fig. 1), 57 (Figs. 6 and 7) are provided along transverse side edges of the diaper to extend circumferentially along leg-openings that are defined when the diaper is put on the diaper wearer.

The covering member 3 (Fig. 2) 40 consists of an elastically stretchable first layer 40a (3a, Fig. 2) and an inelastically stretchable second layer 40b (3b, Fig. 2) shown in Fig. 7 and discussed in the paragraph bridging pages 14 and 15 of appellant's original specification.

As shown in Fig. 4 and discussed in the paragraph bridging pages 9 and 10 of appellant's original specification, the inelastically stretchable second layer 3b (40a) is formed of a plurality of continuous fibers 20 which continuous fibers are fixed to the elastically stretchable first layer 3a (40a) in bonding zones 21 spaced apart from each other so that a ratio of L_1/D_1 , where L_1 is a length of the continuous fibers extending between a first pair of the bonding zones in a first zone on the covering member and D_1 is a distance in a straight line between the first pair of bonding zones in the first zone of the covering member is larger than a ratio of L_2/D_2 , where L_2 is a length of the continuous fibers extending between a second pair of the bonding zones in a second zone on the covering member and D_2 is a distance in a straight line between the second pair of bonding zones in the second zone of the covering member (the first and second zones (or ranges) "A" and "B" are shown in Figs. 3 and 7).

The stretchability of the first and second zones (or ranges) A and B allows the covering member 3, 40 to more easily stretched in a direction away from the skin contactable surface in the first zone (or range) A than in the remaining zone of the covering member 3, 40. As shown in Figs 2 and 7, the first zone (or range) A is adjacent the liquid-absorbent core member 4, 44 and at least substantially coextensive with the liquid-absorbent core member 4, 44, so that pressure exerted on the covering member 40 by the liquid-absorbent core member will stretch the first zone (or range) A in the direction of the skin contactable surface without exerting any pressure on the discrete elastic members (See discussion in paragraph bridging pages 7 and 8 of appellant's original specification).

The elastically stretchable first layer is in a transversely middle zone of the diaper as shown in Figs. 2 and 7 and is formed of an elastically stretchable film as discussed in the paragraph bridging pages 14 and 15 of appellant's original specification.

The continuous fibers of the inelastically stretchable second layer 3b (40b) are made of polypropylene as discussed in the paragraph bridging pages 8 and 9 of appellant's original specification.

The elastically stretchable first layer 3a (40a) is formed from a liquid-impervious sheet and lies inside the second layer as shown in Figs. 2 and 7.

The elastically stretchable first layer 3a (40a) is formed from a liquid-impervious sheet and lies inside the inelastically stretchable second layer 3b (40b) so that the elastically stretchable first layer functions as a liquid-impervious backsheet for the liquid-absorbent core member as shown in Figs. 2 and 7.

The continuous fibers of the inelastically stretchable second layer 3b (40b) are made of propylene copolymers as discussed in the paragraph bridging pages 8 and 9 of appellant's original specification.

The first zone (or range) A is a transversely middle zone of said diaper as discussed on page 7, lines 1-4 of appellant's original specification.

The elastically stretchable first layer 3a (40a) is formed of an elastically stretchable film as set forth in original claim 3.

The continuous fibers 20 of said inelastically stretchable second layer 3b (40b) are made of polypropylene as discussed on page 8, lines 17-18 of appellant's original specification.

The elastically stretchable first layer 3a (40a) is formed from a liquid-impervious sheet and lies inside said second layer 3b (40b) as discussed on page 6, lines 8-18 and shown in Fig. 4.

Moreover, the elastically stretchable first layer 3a (40a) is formed from a liquid-impervious sheet and lies inside said inelastically stretchable second layer 3b (40b) so that said elastically stretchable first layer 3a (40a) functions as a liquid-impervious backsheet for said liquid-absorbent core member as discussed on page 6, lines 8-18 and shown in Fig. 4.

The elastically stretchable first layer 3a (40a) is formed of a nonwoven fabric made of crimped fibers as set forth in original claim 3.

The continuous fibers of said inelastically stretchable second layer 3b (40b) are made of propylene copolymers as discussed on page 8, lines 17-18 of appellant's original specification.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 1-6, 8 and 9 satisfy the written description requirement of 35 U.S.C. §112, first paragraph.

Whether claims 1-3 are anticipated by Divo et al. under 35 U.S.C. §102(b), or obvious over Divo et al. under 35 U.S.C. §103(a).

Whether claims 4, 8 and 9 are unpatentable over Divo et al alone or Divo et al., Serbiak et al. and Morman et al. in view of Estey et al. under 35 U.S.C. §103(a).

Whether claims 5 and 6 are unpatentable over Divo et al., Serbiak et al. and Morman et al. under 35 U.S.C. §103(a).

ARGUMENT

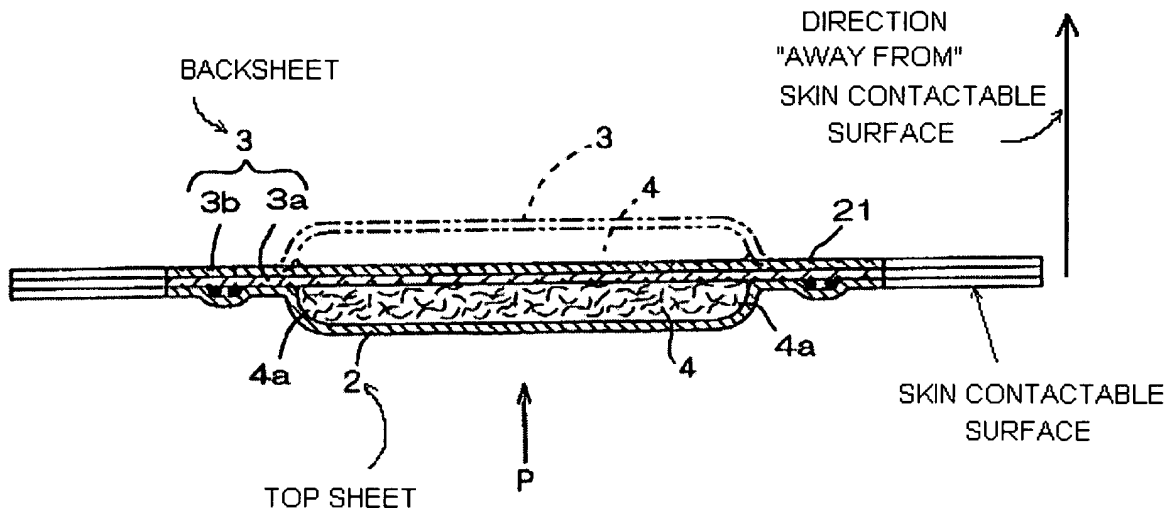
Rejection of Claims 1-6 Under 35 U.S.C. §112, First Paragraph

This rejection is based upon the Examiner's position that the recitation "direction of the skin contactable surface" was opposite to "direction away from the skin contactable surface." In response to the Examiner's position and further clarification in the Advisory Action of March 13, 2006 in which the Examiner stated that "the entire claim 1 is not identical to the 7-20-04 claim 1," claim 1 has been amended to recite that "so that pressure exerted on said covering member by said liquid-absorbent core member will stretch the first zone in said direction away from the skin contactable surface."

This is the same language that was presented in claim 1 on July 20, 2004.

This language is believed to meet the written description requirements of 35 U.S.C. §112, first paragraph inasmuch as this language accurately describes the invention as shown and described in reference to appellant's Fig. 2, reproduced herein:

FIG.2



Rejection of Claims 1-3 under 35 U.S.C. §102(b) as being anticipated by Divo et al. or, in the alternative, under 35 U.S.C. §103(a) as being obvious over Divo et al. in view of Serbiak et al. and Morman et al.

The Examiner had relied upon Divo et al. by referring to:

Figures 1-4, 6, 9-13, lines 31-39, portion(s) selectively "activated" while other remaining or second portion(s) remain unactivated, col. 1, lines 3-16, col. 3, lines 52-55, (it is noted "elongation as defined by the dictionary means "stretched out, lengthened), col. 8, line 6-col 9, line 6 (Note definition of "nonwoven" in Materials Handbook provided in a previous Office Action), col. 9, line 19-col 10, line 19, col. 11, lines 20-46, col.12, line 20-col. 13, line 5, col. 14, lines 28-30, col. 15, line 42 - col. 16, line 4, i.e. the cover is 26, the previous sheet is 24, the core is 28, the elastic members are 32, the first layer is 5 or 11, the second layer is 3 or 7 and 15.

The Examiner stated that:

Figures 2-3, col. 3, lines 52-55, col. 11, lines 20-46, and col. 6, lines 31-39 disclose the ratio set forth on lines 11-19 of claim 1, i.e. teach the nonwoven, i.e. continuous fibers, are activated in a first zone, e.g. the continuous fibers are longer between

bonding points due to gathering, and not activated in a remaining or second zone, i.e. the continuous fiber are shorted between bonding points because not gathered.

The Examiner moreover stated that:

It is the Examiner's first position that col. 6, lines 31-39 also teach the structure of the lines 21-23 of claim 1 and claim 2.

and:

Lines 19-21 and 23 *et seq* of claim 1, as best understood, note new matter rejection supra, recite function or capability of the claimed structure.

The Examiner has concluded:

The Divo device includes the same structure, see cited portions above. Therefore there is sufficient factual basis to conclude that the function or capability of the claimed structure is also inherent in the same structure of Divo.

Appellant's independent claim 1 recites, in part:

.. said covering member consisting of an elastically stretchable first layer and an inelastically stretchable second layer formed of a plurality of continuous fibers, said continuous fibers being fixed to said elastically stretchable first layer in bonding zones spaced apart from each other so that a ratio of L_1/D_1 , where L_1 is a length of said continuous fibers extending between a first pair of said bonding zones in a first zone on said covering member and D_1 is a distance in a straight line between said first pair of bonding zones in said first zone of said covering member is larger than a ratio of L_2/D_2 , where L_2 is a length of said continuous fibers extending between a second pair of said bonding zones in a second zone on said covering member and D_2 is a distance in a straight line between said second pair of bonding zones in said second zone of said covering member, whereby said covering member is more easily stretched in a direction away from the skin contactable surface in said first zone than in said second zone of said covering member, and said first zone being adjacent said liquid-absorbent core member and at least substantially coextensive with said liquid-absorbent core member, so that pressure exerted on said covering member by said liquid-absorbent core member will stretch the first zone in said direction away from

the skin contactable surface without exerting any pressure on said discrete elastic members.

Divo et al. does not teach the structure required by appellant's independent claim 1.

The configuration of the first and second zones and their particular L/D ratios and stretchabilities in relationship to the discrete elastic members that are provided adjacent the leg-opening provides a unique, structurally-related function in appellant's invention.

As discussed in appellant's specification:

Only the range A of the backsheet 3 is deformed as indicated by chain lines in Fig. 2. The core member 4 shifts its position so as to protrude outwardly of the diaper 1 when the diaper 1 is put on a wearer's body with the topsheet 2 placed against the wearer's skin under pressure P exerted on the core member 4 (See Figs. 2 and 3). The pressure P is adequately dampened by the stretching of the range A to avoid exerting pressure on the elastic members 17 of the leg-openings via the ranges B. Thus, there is no apprehension that the desired fitness of the elastic members 17 around the wearer's legs might be adversely affected by the pressure P. In this way, the elastic members 17 associated with the leg-openings cooperate with the ranges B, which are less stretchable than the range A, so to maintain the desired fitness of the diaper 1 around the wearer's legs. It is unnecessary for such diaper 1 to use elastic members 17 associated with the leg-openings that have a relatively high stretch stress to compensate for the influence of the pressure P. With such diaper 1 according to the present invention, there is no anxiety that the elastic members 17 will have a relatively high stretch stress that might be unacceptably pressed around the wearer's legs. (paragraph bridging pages 7 and 8)

In contract to appellant's invention which requires the centrally located range A (first zone) to be have a larger L/D ratio than range B (second zone), Divo et al. depicts attaching the composite elastic member 37 to waist regions 34 and/or the areas 27 defining the leg openings (Col. 17, lines 31-35).

Such a teaching is completely opposite to appellant's invention.

Accordingly, Divo et al. cannot be relied upon as anticipating appellant's claimed invention.

The Examiner has relied upon each of Serbiak et al. and Morman et al. as teaching that:

...it is known in the diaper art to provide elasticity to a backsheet consisting of a composite elastic member wherein only the transverse middle zone part is extensible which the remainder is not.

In combining the teachings of Divo et al. with Serbiak et al. and Morman et al. the Examiner has taken the position that:

...to make the part of the composite which is activated or extensible only the transverse middle portion of the backsheet as taught by Serbiak et al and Morman et al on the Divo et al device would be obvious to one of ordinary skill in the art in view of the recognition that such would provide a backsheet where only a portion is activated which the remainder is not as desired by Divo et al.

The Examiner states that:

Lines 19-21 and 22 et seq of claim 1 recite function or capability of the claimed structure. The prior art combination teaches the same structure, see cited portions above. Therefore there is clear and convincing evidence that the claim's functional or characteristic recitation necessarily flows and/or is inevitable present in the teachings of the prior art of record.

The Examiner's analysis fails to properly consider the overall teachings of the prior art in view of appellant's claimed invention.

Divo et al. teaches that "activation" involves "permanently elongating or rupturing the layer 3" (column 8, lines 30-33) and that "stretching the non-woven will cause the fibers in the layer 3 to become disentangled to a certain extent or will cause a number of fibers to break."

It is clear that Divo et al. is not at all concerned with processing the composite so as to

produce appellant's claimed L/D ratio. That is, if the fibers break or the entire layer 3 ruptures (such events which are allowed for in Divo et al.), the result is that the structure fails to meet appellants' claimed L/D ratio.

It is further noted that, Divo et al. does not teach the limitations for which the Examiner has relied upon Serbiak et al. and Morman et al., i.e., that the activated regions are limited to a central zone of the covering member of a diaper.

In fact the only actual description of selective activated regions taught by Divo et al. involves the physical deformation process which is used to develop the activated portions. These are illustrated as the pleats in the figures of Divo et al., which as the Examiner will note, do not limit the activated areas to a central zone as required by appellant's claimed invention.

The Examiner has found it necessary to rely upon Serbiak et al. and Morman et al. as teaching that:

...it is known in the diaper art to provide elasticity to a backsheet consisting of a composite elastic member wherein only the transverse middle zone part is extensible which the remainder is not.

A careful reading and analysis of each of Serbiak et al. and Morman et al. reveals that the teachings of these references are limited to providing a composite sheet for diapers which have longitudinal or transverse stretchability.

The Examiner's attention is directed to Serbiak et al. at column 2, lines 12-14; column 2, line 65 through column 3, line 1; column 8, lines 19-22; column 10, lines 24-30; and column 11, lines 16-18.

From these passageways it is clear that Serbiak et al. only teaches that the extensible

characteristics of the “base structure” involve longitudinal and transverse stretchability - inasmuch as it Serbiak et al. certainly teaches that if the “base structure” is attached to the absorbent core, the result will be that there is nonextensibility over the coextensive areas of the absorbent core and the “base structure.”

Likewise, the Examiner’s attention is directed to Morman et al. at column 8, lines 41-46 whereat Morman teaches that:

In the embodiment of FIG. 3, absorbent pad 24 may be bonded to inner liner 22 to help retain pad 24 in place but it is not bonded to the outer cover provided by the composite of webs 10 and 12 so as to permit expansion and contraction of the latter to provide a smooth and comfortable fit on the wearer.

As can be understood, from the above, the composite sheets of both Serbiak et al. and Morman et al. are: 1) stretchable at least in the transverse direction; and 2) will become “non extensible” (Serbiak et al.) or not subject to “expansion and contraction” (Morman et al.) if bonded to the respective absorbent members.

It accordingly follows that the teachings of Serbiak et al. and Morman et al. fail to teach a structure that meets the limitation of appellant’s independent claim 1 that requires:

... so that pressure exerted on said covering member by said liquid-absorbent core member will stretch the first zone in said direction away from the skin contactable surface without exerting any pressure on said discrete elastic members.

Clearly, the characteristics and nature of the extensible and stretchable composite sheets of Serbiak et al. and Morman et al. are taught as being such that any force or pressure applied to the respective absorbent core would affect force or pressure on any adjacent leg elastic members.

Note, Serbiak et al. even teaches that if the extensive zones cover a sufficient area of the

absorbent article, neither the leg elastics 40 or the waist elastics 38 may be required. That is because there is no isolation of the forces that are generated in the extensive zones - such forces will extend to and eliminate the need of the leg and waist elastic members.

Clearly there is no provision that could be considered as "isolation" of leg elastic members from forces acting on the adjacent stretchable sheets of Serbiak et al. or Morman et al.

Thus, these references fail to render obvious this feature and limitation of appellant's claimed invention.

It accordingly, follows that the combination of Divo et al. with either Serbiak et al or Morman et al. fails to render obvious this feature and limitation of appellant's claimed invention.

Should the Examiner consider that the combination of prior art inherently renders appellant's claimed invention obvious, it is noted that inherency and obviousness are entirely different concepts. As held by the CCPA in *In re Shetty*:

That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is known. (*In re Shetty*, 195 USPQ 753 (CCPA 1977))

Based upon the above, it is submitted that Divo et al. alone or in combination with Morman et al. and Serbiak et al. does not anticipate or otherwise render obvious appellant's claimed invention.

Rejection of Claims 4, 8 and 9 stand rejected under 35 U.S.C. §103(a) as being obvious over Divo et al. alone or Divo et al., Serbiak et al. and Morman et al. in view of Estey et al.

The Examiner has relied upon Estey et al. as teaching:

...in the diaper art, in elastic composition, the interchangeability of elastic films and

nonwovens of noncrimped fibers with elastic webs of crimped fibers and the interchangeability of polyethylene nonwoven nonelastic for polypropylene or propylene copolymer nonelastic nonwovens.

In combining the teachings of Divo et al., Serbiak et al, Morman and Estey et al. the Examiner takes the position that:

To make the elastic film or nonwoven of noncrimped fibers of Divo et al. a nonwoven material made of crimped fibers instead and to make the second layer of Divo et al. as claimed instead would be obvious to one of ordinary skill in the art in view of the interchangeability as taught by Estey et al.

Estey et al. teaches at column 5, lines 52-58:

Conjugate fibers are also taught in U.S. Pat. No. 5,382,400 to Pike et al. and may be used to produce crimp in the fibers by using the differential rates of expansion and contraction of the two (or more) polymers. Crimped fibers may also be produced by mechanical means and by the process of German Patent DT 25 13 251 A1.

The cited U.S. Patent to Pike et al. teaches:

To increase the bulk or fullness of the bicomponent nonwoven webs for improved fluid management performance or for enhanced "cloth-like" feel of the webs, the bicomponent filaments or fibers are often crimped.

It is accordingly submitted that the reference to crimped fibers in Estey et al. has to do with increasing the bulk of nonwovens.

In contrast, Divo et al. teaches crimping of composite members (not fibers used to form components of there composite members) for purposes of physically deforming the composite members and "to render the composite member elastically elongatable" (column 3, lines 26-28)

It is submitted that the type and function of the crimped fibers taught by Estey et al.

(crimping the fibers before they are formed into webs for purposes of increasing bulk) is not at all related to the crimping taught by Divo et al.

Accordingly, there is no basis for inferring that the two are equivalents so that the teachings of Estey et al. can be applied and used to modify Divo et al.

It would seem that crimping the fibers to bulk the composite members of Divo et al. would hinder the desire to impart elastical elongatability inasmuch as if the individual crimped fibers were stretched to become uncrimped or less crimped or deformed, they would not be effectively activated as required by Divo et al.

Accordingly, it is submitted that there is no basis upon which to establish that the teachings of Estey et al. are applicable to Divo et al.

Accordingly, the combination of Divo et al., Serbiak et al, Morman et al. and Estey et al. is improper under 35 U.S.C. §103.

It is noted that Estey et al. teach improving the hysteresis of a composite. This appears to be opposite or contrary to the goals of Divo et al.

Rejection of Claims 5 and 6 stand rejected under 35 U.S.C. §103(a) as being obvious over Divo et al. alone or Divo et al., Serbiak et al. and Morman et al.

Under this rejection the Examiner has conceded that:

Divo et al. only discloses such elastic layer as being elastic films or nonwovens and coextensive with the second layer initially and the desire that the backsheet be liquid impervious and have a clothlike appearance.

The Examiner has relied upon Serbiak et al. as teaching:

..in the diaper art, in elastic composites, the interchangeable of elastic pervious films and elastic impervious films.

In combining the teachings of Divo et al., Serbiak et al. and Morman et al. the Examiner has taken the position that:

To make the elastic layer the inner most of the two layers as taught by Serbiak et al. on the Divo et al. device would be obvious to one of ordinary skill in the art as providing a more clothlike appearance as desired by Divo et al.

The Examiner's position is not understood. Divo et al. teach attaching the composite elastic member to portions of a sanitary napkin (Figs. 17 and 19). The cross-sectional views (Figs. 18 and 20 depict the elastic members on either side of the backsheets.

It is unclear how the Examiner's proposed modification would benefit Divo et al.

It would seem that the position of the backsheet that is a functional part of the napkin to which the composite elastic members are added cannot be structurally positioned in the manner proposed by the Examiner.

Accordingly, the Examiner's proposed combination of the Divo et al., Serbiak et al. and Morman et al. is not believed to truly be obvious as required under 35 U.S.C. §103.

CONCLUSION

For the reasons advanced above, appellant respectfully contends that the rejection of claims 1-6 should properly be withdrawn as the claims satisfy this section of the statute.

Further for the reasons advanced above, appellant respectfully contends that the rejection of claims 1-3 stand rejected under 35 U.S.C. §102(b) as being anticipated by Divo et al. or, in the alternative, under 35 U.S.C. §103(a) as being obvious over Divo et al. in view of Serbiak et al. and Morman et al. is improper as the examiner has not met his burden of establishing anticipation or a prima facie case of obviousness.

Further for the reasons advanced above, appellant respectfully contends that the rejection of claims 4, 8 and 9 stand rejected under 35 U.S.C. §103(a) as being obvious over Divo et al. alone or Divo et al., Serbiak et al. and Morman et al. in view of Estey et al. is improper as the examiner has not met his burden of establishing a prima facie case of obviousness.

Further for the reasons advanced above, appellant respectfully contends that the rejection of claims 5 and 6 stand rejected under 35 U.S.C. §103(a) as being obvious over Divo et.al. alone or Divo et al., Serbiak et al. and Morman et al. is improper as the examiner has not met his burden of establishing a prima facie case of obviousness.

Reversal of each of the rejections on appeal is respectfully requested.

To the extent necessary, a petition for an extension of time under 37 CFR §1.136 is hereby made. Please charge the fees due in connection with the filing of this paper, including extension of

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time fees, to Deposit Account No. 12-2136 and please credit any excess fees to such deposit account.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Michael S. Gzybowski", with a long, sweeping horizontal line extending to the right.

Michael S. Gzybowski
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159681.1

CLAIMS APPENDIX

Claim 1. A disposable diaper comprising:

an elastically stretchable covering member for covering a diaper wearer's crotch and waist regions;

a liquid-pervious sheet having a skin contactable surface for contacting with skin of said diaper wearer;

a liquid-absorbent core member sandwiched between said liquid-pervious sheet and said covering member;

discrete elastic members provided along transverse side edges of said diaper to extend circumferentially along leg-openings that are defined when the diaper is put on the diaper wearer;

said covering member consisting of an elastically stretchable first layer and an inelastically stretchable second layer formed of a plurality of continuous fibers, said continuous fibers being fixed to said elastically stretchable first layer in bonding zones spaced apart from each other so that a ratio of L_1/D_1 , where L_1 is a length of said continuous fibers extending between a first pair of said bonding zones in a centrally located first zone on said covering member and D_1 is a distance in a straight line between said first pair of bonding zones in said first zone of said covering member is larger than a ratio of L_2/D_2 , where L_2 is a length of said continuous fibers extending between a second pair of said bonding zones in a second zone on said covering member and D_2 is a distance in a straight line between said second pair of bonding zones in said second zone of said covering member, whereby said covering member is more easily stretched in a direction away from the skin contactable surface in said first zone than in said second zone of said covering member, and said first

zone being adjacent said liquid-absorbent core member and at least substantially coextensive with said liquid-absorbent core member, so that pressure exerted on said covering member by said liquid-absorbent core member will stretch the first zone in said direction of the skin contactable surface without exerting any pressure on said discrete elastic members.

Claim 2. The diaper according to Claim 1, wherein said first zone is a transversely middle zone of said diaper.

Claim 3. The diaper according to Claim 1, wherein said elastically stretchable first layer is formed of an elastically stretchable film.

Claim 4. The diaper according to Claim 1, wherein said continuous fibers of said inelastically stretchable second layer are made of polypropylene.

Claim 5. The diaper according to Claim 1, wherein said elastically stretchable first layer is formed from a liquid-impervious sheet and lies inside said second layer.

Claim 6. The diaper according to Claim 1, wherein said elastically stretchable first layer is formed from a liquid-impervious sheet and lies inside said inelastically stretchable second layer so that said elastically stretchable first layer functions as a liquid-impervious backsheet for said liquid-absorbent core member.

Claim 8. The diaper according to Claim 1, wherein said elastically stretchable first layer is formed of a nonwoven fabric made of crimped fibers.

Claim 9. The diaper according to Claim 1, wherein said continuous fibers of said inelastically stretchable second layer are made of propylene copolymers.

EVIDENCE APPENDIX

1. *In re Shetty*, 195 USPQ 753 (CCPA 1977)

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RELATED PROCEEDINGS APPENDIX

Not Applicable

or writ of certiorari to Court of
the Ninth Circuit denied.
elow; 192 USPQ 481 (Pat. No.

Court of Customs and Patent Appeals

In re Shetty

No. 77-515 Decided Nov. 17, 1977

PATENTS

1. Patentability — Invention — Specific cases — Chemical (§51.5093)

It is obvious and there is sufficient motivation to person skilled in chemical or pharmaceutical arts to substitute ethylene link between adamantane ring and amine for structurally-similar prior art methylene link.

2. Patentability — Invention — In general (§51.501)

Patentability — Invention — Specific cases — Chemical (§51.5093)

Fact that claimed method might be inherent in teachings of prior art is immaterial if one of ordinary skill in art would not appreciate or recognize that inherent method; mere hindsight assertion that corresponding dosages of prior art compounds useful for combatting microbial infestation, in light of which claimed compound is obvious, renders claimed method for appetite control obvious is untenable; inherency of advantage and its obviousness are entirely different questions; obviousness cannot be predicated on what is unknown.

Particular patents — Adamantane Derivatives

Shetty, Anorectic Adamantane Derivatives and Method of Using Same, rejection of claim 52 affirmed; rejection of claims 2-5 and 51 reversed.

Appeal from Patent and Trademark Office Board of Appeals.

Application for patent of Bola Vithal Shetty, Serial No. 171,736, filed Aug. 13, 1971. From decision rejecting claims 2-5, 51, and 52, applicant appeals. Modified.

Carl A. Hechmer, Jr., and Edward A. Sager, both of Philadelphia, Pa., for appellant.

Joseph F. Nakamura (Jack E. Armore, of counsel) for Commissioner of Patents and Trademarks.

Before Markey, Chief Judge, Rich, Baldwin, and Lane, Associate Judges, and Morgan Ford, Associate Judge, United States Customs Court.

Rich, Judge.

This appeal is from that portion of the July 30, 1976, decision of the Patent and Trademark Office (PTO) Board of Appeals (board) rejecting claims 2-5, 51, and 52 in application serial No. 171,736, filed August 13, 1971, entitled "Anorectic Adamantane Derivatives and Method of Using Same." The board rejected the claims under 35 USC 103 on new grounds, as provided in 37 CFR 1.196(b), as obvious from Brake¹ in view of Narayanan,² Bernstein et al.,³ and Bernstein.⁴ We affirm the rejection of composition claim 52 and reverse the rejection of method claims 51 and 2-5.

The Invention

The invention pertains to a method, as defined in claims 51 and 2-5, of curbing appetite in animals by administering certain adamantane compounds.⁵ The invention also pertains to the unit dosage form of a composition for curbing appetite comprising such an adamantane compound and a pharmaceutically acceptable carrier as defined in claim 52.

In the specification, appellant identifies his claimed compounds as follows:

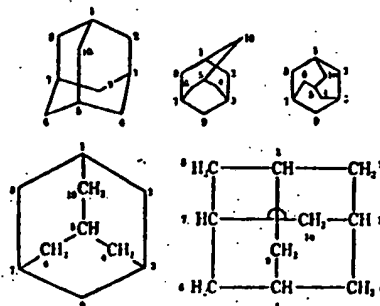
¹ U.S. Patent No. 3,489,802, issued Jan. 13, 1970, on application serial No. 610,779, filed Jan. 23, 1967.

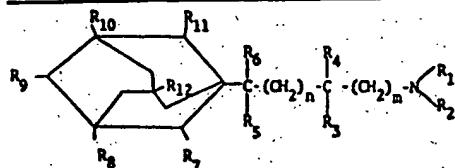
² U.S. Patent No. 3,501,511, issued Mar. 17, 1970, on application serial No. 661,781, filed Aug. 21, 1967.

³ U.S. Patent No. 3,270,036, issued Aug. 30, 1966, on application serial No. 493,899, filed Oct. 7, 1965.

⁴ U.S. Patent No. 3,320,249, issued May 16, 1967, on application serial No. 470,930, filed July 9, 1965.

⁵ Adamantane is the trivial name assigned to tricyclodecane. Its structural formula can be represented in any of the following ways:



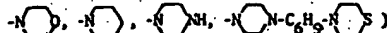


or their pharmaceutically acceptable acid addition salts, wherein:

R_1 = H, lower alkyl, aralkyl, aralkyl substituted with NH_2 , OH, OCH_3 , halogen, alkyl, NO_2 ; phenoxyalkyl or phenoxyalkyl substituted with NH_2 , OH, OCH_3 , halogen, alkyl, or NO_2 ; acyl such as formyl or acetyl.

R_2 = H, lower alkyl, COO-lower alkyl, aralkyl, aralkyl substituted with NH_2 , OH, OCH_3 , halogen, alkyl, NO_2 ; phenoxyalkyl or phenoxyalkyl substituted with NH_2 , OH, OCH_3 , halogen, alkyl, or NO_2 ; acyl such as formyl or acetyl.

R_1 and R_2 can be joined together to form, with the nitrogen, a heterocyclic ring (e.g.



R_3 = H, lower alkyl, or alkynyl

R_4 = H, lower alkyl, or alkynyl

R_5 = H, OH, halogen, or lower alkyl

R_6 = H, OH, halogen, or lower alkyl

R_7 and R_8 together may represent a carbonyl oxygen

R_9 = H, lower alkyl, halogen, hydroxy, alkoxy, amino or substituted amino, trifluoromethyl, sulfamyl, nitro, phenyl

R_{10} , R_{11} , R_{12} , are any of R_9 ,

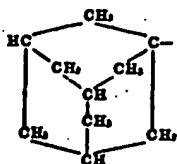
$n = 0$ to 4

$m = 0$ to 4

Independent claim 51 defines the "method of curbing appetite in an animal which comprises administering to the animal an amount effective to curb appetite of a compound" of the above formula:

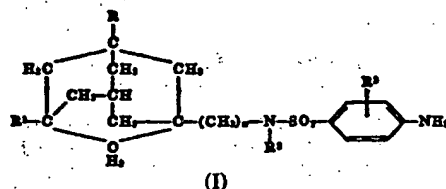
The References

Brake describes a process for improving the yield of α -methyl multicyclic methylamines, one of which is α -methyl-1-adamantanemethylamine, illustrated as:



and is described as being useful as an antiviral agent in animals.

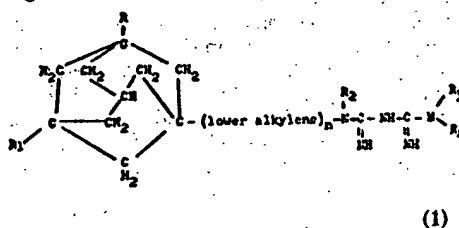
Narayanan teaches adamantyl sulfonamide compounds, useful as antimicrobial agents, e.g., as antiviral agents, of the formula:



wherein R and R_1 each is hydrogen, halogen, lower alkyl, phenyl or phenyl-lower alkyl, R_2 is hydrogen or lower alkyl, R_1 is hydrogen, lower alkyl, lower alkoxy, halogen or halo-lower alkyl and n is 0, 1 or 2, and salts thereof.

Narayanan also teaches the use of his compounds in dosages corresponding to those of appellant.

Bernstein et al. pertains to adamantyl biguanides of the formula:

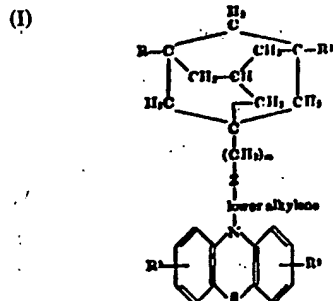


and to acid-addition salts thereof.

In Formula I, R and R_1 each is hydrogen, halogen, lower alkyl, phenyl or lower alkoxy, R_2 , R_3 and R_4 each is hydrogen, lower alkyl or phenyl-lower alkyl and n is 0 or 1.

These compounds are hypoglycemic agents effective in reducing blood sugar content in mammals.

The compounds of the Bernstein patent are illustrated by the following formula:



and to acid-addition and quaternary ammonium salts thereof.

These compounds are adamantyl derivatives of phenthiazines, therapeutically active as central nervous system depressants.

The Rejection

The examiner rejected appellant's claimed composition and method as obvious under 35 USC 103 in view of the teaching in Brake of administering to animals structurally similar adamantane derivatives "analogous" to those claimed. The Bernstein and Narayanan patents were cited to show similar compounds in the art. The examiner reasoned that the composition claim would have been obvious from the prior art because the respective compounds differ merely by a methylene group, i.e., the instant compounds have at least an ethylene link between the adamantane ring and the amine, whereas the prior art compound has a methylene link. This "minor molecular modification" was further asserted to be made obvious by the Bernstein and Narayanan patents, which disclose lower alkylene links between adamantane and other moieties and are directed to pharmaceutical uses.

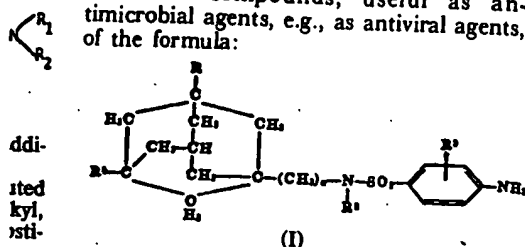
The board treated the examiner's rejection as relying upon Brake alone and as citing the Bernstein and Narayanan patents to show the state of the art. The board did not sustain the rejection of claims 2-5, 51, and 52 as obvious from Brake alone because Brake's failure to disclose an amount of his compound effective as an antiviral agent renders unobvious the administration of "adjacent homologs of Brake's compound 'in an amount effective to curb appetite' * * *." Similarly, the board did not agree that appellant's composition in an "appetite curbing amount" would have been obvious from Brake alone.

Under 37 CFR 1.196(b), the board made a new ground of rejection under 35 USC 103 for obviousness from Brake in view of the Bernstein and Narayanan patents. The board agreed with the examiner that appellant's compounds having an ethylene linkage would have been obvious in view of Brake's corresponding adjacent homolog (methylene linkage). Relative to the method claims, the board found sufficient motivation in the prior art to administer Brake's compound and adjacent ethylene "homologs" as antiviral agents, and concluded that administering appellant's compounds in appetite-curbing amounts would have been obvious from Brake and Narayanan since the amounts suggested by Narayanan to achieve antiviral effects encompass the amounts intended and claimed by appellant.

The Arguments

Appellant contends that, after refusing to sustain the examiner's rejection on the basis

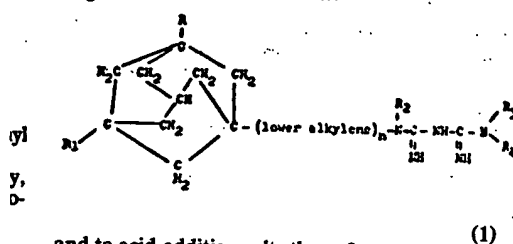
Narayanan teaches adamantyl sulfonamide compounds, useful as antimicrobial agents, e.g., as antiviral agents, of the formula:



wherein R and R' each is hydrogen, halogen, lower alkyl, phenyl or phenyl-lower alkyl, R² is hydrogen or lower alkyl, R³ is hydrogen, lower alkyl, lower alkoxy, halogen or halo-lower alkyl and n is 0, 1 or 2, and salts thereof.

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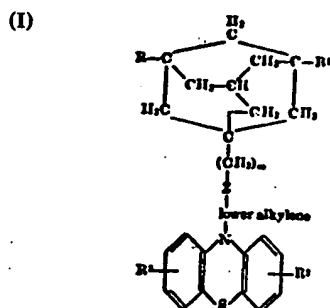


and to acid-addition salts thereof.

In Formula I, R and R' each is hydrogen, halogen, lower alkyl, phenyl or lower alkoxy, R², R³, and R_n each is hydrogen, lower alkyl or phenyl-lower alkyl and n is 0 or 1.

These compounds are hypoglycemic agents effective in reducing blood sugar content in mammals.

The compounds of the Bernstein patent are illustrated by the following formula:



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The board treated the examiner's rejection as relying upon Brake alone and as citing the Bernstein and Narayanan patents to show the state of the art. The board did not sustain the rejection of claims 2-5, 51, and 52 as obvious from Brake alone because Brake's failure to disclose an amount of his compound effective as an antiviral agent renders unobvious the administration of "adjacent homologs of Brake's compound in an amount effective to curb appetite" * * *. Similarly, the board did not agree that appellant's composition in an "appetite curbing amount" would have been obvious from Brake alone.

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The Arguments

Appellant contends that, after refusing to sustain the examiner's rejection on the basis

of Brake alone, the board erred in rejecting the method claims by considering Narayanan in addition to Brake. Appellant argues that Narayanan's reference to dosage for treating viral infection is an improper basis for rejection. It is urged that the board mistakenly assumed that appetite-suppressant effects of appellant's compounds would be readily recognized from treating virus-infected animals with a related compound. It is also urged that the board ignored differences in treatments for viral infection and obesity, and that therefore Narayanan's dosage cannot be said to result in effective anorexia. Relative to the claimed composition, appellant states that there is an appreciable difference between the structure of the compounds of the claim and the prior art compounds, and that the former would not have been obvious because the motivation to make the required structural variation is absent.

The solicitor responds by arguing that in the absence of comparative evidence of any unexpected difference in the properties of appellant's and Brake's compounds, the compounds of the claim would have been obvious from and unpatentable over the structurally closely related compound disclosed by Brake. It is argued that Brake and Narayanan render obvious appellant's pharmaceutical carrier and "unit dosage form." As to the method claims, the solicitor contends that Narayanan discloses adamantyl compounds as antiviral agents in dosages that correspond to and would suggest similar and inherently appetite-curbing amounts of the Brake antiviral compound. The solicitor supports the board position that because appellant's compounds are homologous and there is sufficient motivation in the prior art to administer Brake's compound as an antiviral agent, appellant's different purpose does not render the method claims unobvious.

Opinion

We note at the outset that the ethylene linkage of appellant's compound closest to the prior art (β -(1-adamantyl)- α -methylethylamine) is referred to by the examiner as "analogous" to the methylene linkage of Brake's α -methyl-1-adamantanemethylamine and by the board as a "homolog." Since the appellant has not challenged either of these classifications, we proceed on the assumption that he accepts the inference that his compounds, whether homologs or analogs, would be expected to have similar properties to the prior art compound. Whether the adamantyl compounds in question are properly classified according

to the usual definitions of "homolog" and "analog," we shall not consider inasmuch as appellant has not argued the point.

The solicitor has taken the position that absent comparative evidence demonstrating any unexpected difference in the properties of the compounds, the claimed composition would have been obvious from and unpatentable over the structurally closely related compound disclosed in Brake. On the other hand, appellant contends that the presence of the ethylene rather than the methylene group constitutes "an appreciable difference in the claimed compound and the prior art compounds," and relies on *In re Taborsky*, 502 F.2d 775, 183 USPQ 50 (CCPA 1974) for support of his argument that without some teaching of motivation to make the required molecular variation, a finding of obviousness based on structural similarity is improper.

[1] Regarding this issue of structural similarity, we agree with the solicitor and the PTO position. The examiner noted the difference of a mere methylene group between the compound of the claim and the prior art compounds, cited the Bernstein and Narayanan references showing the state of the art as prior art knowledge of use of lower alkylene links between adamantane and other moieties, and concluded that "this minor molecular modification would clearly be obvious to the pharmaceutical chemist." We do not accept appellant's contention that the adjacent alkylene link in question constitutes an "appreciable difference" in the compounds. We think that a person skilled in chemical and/or pharmaceutical arts would not hesitate to extend the alkylene linkage of the prior art compound. Further, we note that appellant's compound closest to the prior art and its synthetic preparation are disclosed in Narayanan as one of a group of compounds for producing his adamantyl sulfonamide. This leaves no room for doubt that the prior art knowledge renders appellant's compound structurally similar and provides sufficient motivation to make it.

Moreover, appellant has no basis for relying on *Taborsky*, supra. Unlike the present case, the prior art of record in *Taborsky* expressly limited the scope of "halogen" to exclude appellant's claimed fluorosalicylanilide compounds and stated "several disadvantages in practice" of free salicylanilides. 502 F.2d at 781, 183 USPQ at 55 (emphasis supplied). Appellant here has shown no such reason to preclude the conclusion that appellant's compounds are

structurally similar to the prior art compounds.

Confronted with PTO evidence of obviousness, appellant has offered no evidence of unobviousness, as by showing an actual difference in properties between his compounds and the prior art compounds. In *re Hoch*, 57 CCPA 1292, 428 F.2d 1341, 166 USPQ 406 (1970). Appellant merely shows that his novel compounds are appetite suppressants whereas the reference compounds are not so known. Further, appellant has not indicated whether his compounds are antiviral, as is Brake's prior art compound. Presented with such an absence of comparative or other evidence with respect to the properties of the compounds and the claimed composition, we hold that composition claim 52 would have been obvious from and unpatentable over the prior art.

[2] Regarding method claims 51 and 2-5, the solicitor agrees with the board that:

* * * the compounds of claim 51 are obvious from and unpatentable over the corresponding Brake compound and the Narayanan disclosure of a dosage which corresponds to appellant's disclosed appetite curbing dosage (therefore, inherently appetite curbing). [Emphasis added.]

We cannot accept this conclusion. The issue here is whether the claimed method of curbing appetite would have been obvious. That appellant's "amount effective to curb appetite" corresponds to or inheres in Narayanan's amount "to combat microbial infestation" does not persuade us of the obviousness of appellant's method. As this court said in *In re Naylor*, 54 CCPA 902, 905-06, 369 F.2d 765, 768, 152 USPQ 106, 108 (1966):

[Inherency] is quite immaterial if, as the record establishes here, one of ordinary skill in the art would not appreciate or recognize that inherent result. * * *

* * * we find nothing in the record which would afford one of ordinary skill reason to anticipate that a trial * * * [of the combined prior art teachings] would be successful in producing the polymer recited in the claims.

The Patent Office has failed to show a reasonable expectation, or some predictability, that Brake's compound would be an effective appetite suppressant if administered in the dosage disclosed by Narayanan. The mere hindsight assertion that corresponding dosages render appellant's method obvious is untenable.

Prior to appellant's disclosure, non adamantane compounds in any references before us suggested a use, less a dosage, for curbing appetite. V said in *In re Spormann*, 53 CCPA 1380, 363 F.2d 444, 448, 150 USPQ (1966), relative to inherency applies here:

As we pointed out in *In re Ad* CCPA 996, 356 F.2d 998, 148 US [(1966)], the inherency of an ad and its obviousness are entirely c questions. That which may be inh not necessarily known. Obviousne not be predicated on what is unl

Accordingly, the decision of the t affirmed as to claim 52 and reverse claims 51 and 2-5.

District Court, N. D. Illinois, E.

Radial Lip Machine, Inc.

v. International Carbide Corporation

No. 73 C 2945 Decided Sept. 29,

PATENTS

1. Pleading and practice in court jury trial — In general (§53.

Accused patent and trademark infringement counterclaim to complaint: damages demands damages for breach of contract and fraud, and payment of royalties under assignment contract presents several grounds for declaratory judgment relief that would have given rise to a jury trial if raised by coercive action, entitled to jury trial on all factual issues common to legal and equitable claims.

2. Pleading and practice in court jury trial — In general (§53.

Case in which only two competitors are involved, length of trial estimated to be three weeks, there is no indication of large number of documents, patent validity is undisputed does not pass limits of jury competence.

Action by Radial Lip Machine against International Carbide Corporation and Numac Research Industries, for patent and trademark infringement which defendants counterclaim

structurally similar to the prior art compounds.

Confronted with PTO evidence of obviousness, appellant has offered no evidence of unobviousness, as by showing an actual difference in properties between his compounds and the prior art compounds. In re Ch, 57 CCPA 1292, 428 F.2d 1341, 166 PQ 406 (1970). Appellant merely shows that his novel compounds are appetite suppressants whereas the reference compounds are not so known. Further, appellant has not indicated whether his compounds are anal, as is Brake's prior art compound. Presented with such an absence of comparative or other evidence with respect to properties of the compounds and the chemical composition, we hold that composition claim 52 would have been obvious from unpatentable over the prior art.

[1] Regarding method claims 51 and 2-5, solicitor agrees with the board that:

* * the compounds of claim 51 are obvious from and unpatentable over the corresponding Brake compound and the arayanan disclosure of a dosage which corresponds to appellant's disclosed appetite curbing dosage (therefore, inherently appetite curbing). [Emphasis added.]

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[Inherency] is quite immaterial if, as the record establishes here, one of ordinary skill in the art would not appreciate or recognize that inherent result. * * *

* * * we find nothing in the record which would afford one of ordinary skill reason to anticipate that a trial * * * [of combined prior art teachings] would be successful in producing the polymer claimed in the claims.

Patent Office has failed to show a reasonable expectation, or some predictability, that Brake's compound would be an effective appetite suppressant if administered in the dosage disclosed by arayanan. The mere hindsight assertion that corresponding dosages render appellant's method obvious is untenable.

Prior to appellant's disclosure, none of the adamantane compounds in any of the references before us suggested a use, much less a dosage, for curbing appetite. What we said in In re Spormann, 53 CCPA 1375, 1380, 363 F.2d 444, 448, 150 USPQ 449, 452 (1966), relative to inherency applies equally here:

As we pointed out in In re Adams, 53 CCPA 996, 356 F.2d 998, 148 USPQ 742 [(1966)], the inherency of an advantage and its obviousness are entirely different questions. That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown.

Accordingly, the decision of the board is affirmed as to claim 52 and reversed as to claims 51 and 2-5.

District Court, N. D. Illinois, E. Div.

Radial Lip Machine, Inc.

v. International Carbide Corporation, et al.

No. 73 C 2945 Decided Sept. 29, 1977

PATENTS

1. Pleading and practice in courts — Jury trial — In general (§53.571)

Accused patent and trademark infringers whose counterclaim to complaint seeking damages demands damages for breach of contract and fraud, and payment of royalties under assignment contract, and presents several grounds for declaratory relief that would have given rise to right to jury trial if raised by coercive action, are entitled to jury trial on all factual issues common to legal and equitable claims.

2. Pleading and practice in courts — Jury trial — In general (§53.571)

Case in which only two competing corporations are involved, length of trial is estimated to be three weeks, there is no inundation of large number of documents, and patent validity is undisputed does not surpass limits of jury competence.

Action by Radial Lip Machine, Inc., against International Carbide Corporation, and Numac Research Industries, Inc., for patent and trademark infringement, in which defendants counterclaim for

declaratory and equitable relief and damages. On plaintiff's motion to strike defendants' demand for jury trial. Motion denied.

William T. Kirby, Roger McFadden, and Hubachek, Kelly, Rauch & Kirby, all of Chicago, Ill. (Robert L. Harmon, Richard H. Compere, and Hume, Clement, Brinks, William, Olds & Cook, Ltd., all of Chicago, Ill., and Vincent L. Barker, Jr., and Owen & Owen, both of Toledo, Ohio, of counsel) for plaintiff.

Jack E. Dominik, Alan B. Samlan, and Dominik, Knechtel, Godula & Demeur, all of Chicago, Ill., for defendants.

Marshall, District Judge.

This is a civil action for patent and trademark infringement and breach of contract. The parties are three corporations involved in the development, manufacture and marketing of a "radial lip" drill which is used in the metal cutting industry. Plaintiff has moved to strike defendants' demand for a jury trial.

The factual background reveals a series of corporate transactions which have transferred patent rights and created numerous contractual obligations between the parties. In the late 1960's officers of the two defendant corporations, International Carbide Corporation and Numac Research Industries, Inc., developed the radial lip drill and applied for patents on the drill, its grinding apparatus and the grinding method. Defendants then entered into various licensing agreements with other corporations. In 1969, defendants executed an agreement with Calar, a holding company. The Calar agreement basically provided that in return for 10% of Calar's stock and a share of outstanding rents and royalties from leases and licensing agreements, defendants would transfer their patent rights and those outstanding contracts and licenses to Calar. Defendants also agreed to perform certain research and technical services for Calar and received a license to make, sell and resharpen radial lip drills. Calar subsequently transferred its interest in the agreement, including the drill patents and trademark, first to its wholly owned sub-

The predecessor of these two corporations was Radial Lip Drill Company, which is to be distinguished from two other similarly named corporations in this case, Radial Lip Machine Corporation (a subsidiary of Calar) and Radial Lip Machine, Inc. (the present plaintiff).

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